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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,647	01/07/2002	Toni Maric Antalis	11168A	3669

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EXAMINER

MONSHIPOURI, MARYAM

ART UNIT PAPER NUMBER

1653

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/040,647

Applicant(s)

ANTALIS ET AL.

Examiner

Maryam Monshipouri

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68, 71 and 74-78 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 71 is/are allowed.
- 6) ☒ Claim(s) 68 and 74-77 is/are rejected.
- 7) ☒ Claim(s) 78 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/023,942.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date Filed 1/7/02
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____

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Claims 1-67, 69-70, 72-73 have been canceled. Claims 68, 71, 74-76 and newly presented claims 77-78 are still at issue and are present for examination.

Applicants' arguments filed on 9/30/2005 have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Information Disclosure Statement

It is noted that applicant submitted some references to be considered in an IDS on 1/7/2002. However, no 1449 is included so that the examiner could sign and date said form. Nevertheless the examiner initialed on the references which were available in the parent case of this application. Applicant is advised to enter said references into an official 1449 form in response to this office action in order to avoid possible printer queries.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 68, 74, 75-76 and 77 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as indicated in the previous office action. In traversal of this rejection applicant argues that on page 17 of the specification, lines 6-12, it is taught as what the "medium stringency" conditions may be. He/she also indicates that in the parent case, which is now U.S. patent 6,479,274,

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claims reciting such term have been allowed and for said reasons the rejection should be withdrawn.

These arguments were fully considered but were found **unpersuasive because of the following reasons:** the examiner agrees with the applicant that on page 17 applicant has pointed out what "medium stringency" conditions includes but said definition is not explicit. In other words, it is not clear what other conditions are embraced but said term. Further, it is true that the examiner may have allowed claims reciting said term in the parent application but said allowance must have occurred to due to an inadvertent error. As applicant is aware several years have elapsed since allowance of the parent case through which the examiner has obtained much more experience in the field of patent Law and unfortunately, presently, she cannot justify repeating an inadvertent error, which may have occurred in the parent case. With respect to the term "high stringency conditions" in claim 77, the same rejection applies (i.e. the term refers to what high stringency conditions may be without explicitly defining said term).

Therefore the rejection remains for the reasons of record in addition to those provided above. Claims 75-76 and 78 remain rejected for depending from rejected base claims 68 and 74.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 68, 74-77 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, according to the previous office action.

In traversal of this rejection once again applicant provides the same arguments as indicated above, which have already been addressed. The examiner would like to emphasize that even though applicant has recited some activity limitation into claims 68, 74 and 77, in view of the broadness of the hybridization conditions used some additional structural information about claimed protein homolog is necessary which is currently lacking from the specification and for said reason the burden of lack of sufficient written description has not been met (see also the previous office action).

Since claimed protease homologs lack adequate written description compositions comprising said products lack adequate written description as well.

Allowable Subject Matter

Claim 71 is allowed for reasons of record.

Claim 78 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. This is because an isolated protein encoded by SEQ ID NO:5 is both novel and non-obvious.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

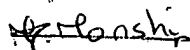
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maryam Monshipouri whose telephone number is (571) 272-0932. The examiner can normally be reached on 7:00 a.m to 4:30 p.m. except for alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weber Jon P. can be reached on (571) 272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Maryam Monshipouri Ph.D.
Primary Examiner
